

## REMARKS

### I. PRELIMINARY REMARKS

A minor modification has been made to the specification. Claims 7, 28 and 30 have been amended. Non-elected claims 1-6 and 13-27 have been canceled.<sup>1</sup> Claims 31-46 have been added. Claims 7-12 and 28-46 remain in the application. Claims 7 and 29 have been withdrawn from consideration. Reexamination and reconsideration of the application, as amended, are respectfully requested.

### II. OBJECTION TO THE CLAIMS

Claim 30 has been objected to. More specifically, the Office Action indicated that it is not clear whether the negative limitation recited in claim 30 is "an intended use or functional limitation" or "a structural limitation." The Office Action also indicated that the negative limitation "provides very little structure that is further limiting to claim 28." The objection is respectfully traversed as it relates to claim 30 as amended above.

Claim 28 includes the transitional phrase "comprising." MPEP § 2111.03 indicates that "[t]he transitional term 'comprising' ... is inclusive or open-ended and does not exclude additional, unrecited elements." As such, the invention set forth in claim 28 includes the elements recited in claim 28 and "additional, unrecited elements." Claim 30 structurally limits claim 28 by indicating that the "additional, unrecited elements" cannot be a specific structure, i.e. "an electrode that is large enough to form a transmural lesion in myocardial tissue [on the] distal region of the tube." The objection to claim 30 should, therefore, be withdrawn.

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<sup>1</sup> Applicant hereby reserves the right to pursue patent protection for the inventions associated with the non-elected claims.

### III. BRIEF DESCRIPTION OF EXEMPLARY EMBODIMENTS

The present inventions, as defined by the claims, are directed generally to surgical systems and apparatus that may be used to stimulate tissue. Referring to Figures 29-32, exemplary systems and apparatus include a suction device 618 that carries one or more tissue stimulation elements 604. Such stimulation elements 604 may be for tissue stimulation, and to sense electrical activity in tissue. [Specification at, for example, page 37, line 21 to page 38, line 3.] The tissue stimulation elements 604 are also too small to form a transmural lesion in myocardial tissue. [Specification at, for example, page 34, lines 17-23 and page 29, lines 21-33.]

### IV. PRIOR ART REJECTION

#### A. The Rejection

Claims 7-11, 28 and 30 have been rejected under 35 U.S.C. § 102 as being anticipated by the U.S. Patent No. 6,652,518 to Wellman ("the Wellman patent"). The rejection under 35 U.S.C. § 102 is respectfully traversed with respect to the claims as amended above. Reconsideration thereof is respectfully requested.

#### B. Discussion

Independent claims 7 and 28 call for respective combinations of elements including, *inter alia*, "a suction device" and "a tissue stimulation element that is **too small to form a transmural lesion in myocardial tissue** on the suction device." The combinations defined by claims 8-11 include, *inter alia*, the elements recited in claim 7, and the combination defined by claim 30 includes, *inter alia*, the elements recited in claim 28.

The Wellman patent fails to teach or suggest the claimed combinations. For example, the Wellman patent is directed to transmural ablation tools that are

specifically designed to form transmural lesions. [Note, for example, column 3, lines 37-41; and column 5, lines 39-52.] The only electrodes carried by the transmural ablation tools are those which form the transmural lesions. There are no tissue stimulation elements that are too small to form transmural lesions in myocardial tissue on the transmural ablation tools. Given the fact that one of the apparent goals of the Wellman transmural ablation tools is to avoid lesion testing and re-ablation when a tested lesion turns out to be less than transmural, this is not unexpected. [Column 2, lines 7-15.]

As the Wellman patent fails to teach or suggest each and every element of the respective combinations recited in independent claims 7 and 28, applicant respectfully submits that claims 7-11, 28 and 30 are patentable thereover and that the rejection under 35 U.S.C. § 102 should be withdrawn.

#### **V. NEWLY PRESENTED CLAIMS 31-46**

Newly presented claims 31-36 depend from independent claim 28 and, accordingly, are patentable for at least the same reasons as claim 28.

Newly presented claims 37-42 depend from independent claim 7 and, accordingly, are patentable for at least the same reasons as claim 7.

Newly presented independent claim 43 calls for an apparatus comprising “a tube,” “a suction device associated with the distal region of the tube” and “tissue stimulation means, carried by the suction device, for stimulating myocardial tissue without forming a transmural lesion in the myocardial tissue.” The Wellman patent fails to teach or suggest such an apparatus. For example, the Wellman transmural lesion apparatus do not include structure that performs the function of “stimulating myocardial tissue without forming a transmural lesion in the myocardial tissue.” Claims 43-46 are, therefore, patentable thereover.

## VI. CLOSING REMARKS

In view of the foregoing, it is respectfully submitted that the claims in the application are in condition for allowance. Reexamination and reconsideration of the application, as amended, are respectfully requested. Allowance of the claims at an early date is courteously solicited.

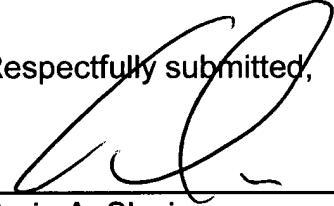
If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is respectfully requested to call applicant's undersigned representative at (310) 563-1458 to discuss the steps necessary for placing the application in condition for allowance.

The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 50-0638. Should such fees be associated with an extension of time, applicant respectfully requests that this paper be considered a petition therefor.

12/1/05  
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Date

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Respectfully submitted,

  
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